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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,021	11/05/2001	Richard P. Welty	270-3038-U	8522

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Masco Corporation
21001 Van Born Road
Taylor, MI 48180

EXAMINER

ZIMMERMAN, JOHN J

ART UNIT	PAPER NUMBER
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1775

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DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,021

Applicant(s)

WELTY ET AL.

Examiner

John J. Zimmerman

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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OFFICE ACTION

1. This Office Action considers the Preliminary Amendment filed with this application on November 5, 2001. Claims 22-27 are pending in this application.

Information Disclosure Statement

2. No information disclosure statement has reached the file of this application as of the mailing date of this Office Action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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4. Claims 22-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Meckel (U.S. Patent 6,076,264).

5. Meckel discloses an article having a first coating layer of zirconium and a second coating layer of zirconium nitride (e.g. see Figure 5A; column 6, line 54 - column 7, line 15).

6. Claims 22-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Meckel (U.S. Patent 6,196,936).

7. Meckel discloses an article having a first coating layer of zirconium and a second coating layer of zirconium nitride (e.g. see Figure 5A; claims 1-4).

8. Claims 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kerber (U.S. Patent Re. 34,173).

9. Kerber discloses an article having a first coating layer which can be zirconium and a second coating layer which can be the nitride of the first coating layer material (e.g. see claim 1). Although it is noted that Kerber may contain multiple additional layers, applicant's claims use "consisting essentially". If applicant contends that components in the prior art are excluded by the recitation of "consisting essentially of", applicant has the burden of showing that the basic and

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novel characteristics of the claimed invention are materially affected by those components, *In re De Lajarte*, 143 USPQ 256 (CCPA 1964).

10. Claims 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Knudsen (U.S. Patent 5,724,868).

11. Knudsen discloses an article having a first coating layer of titanium and a second coating layer of titanium nitride (e.g. see Figure 6A; column 6, lines 28-56).

12. Claims 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Jindal (U.S. Patent 5,264,297).

13. Jindal discloses an article having a first coating layer of titanium and a second coating layer of titanium nitride (e.g. see claim 1).

14. Claims 22 and 23 are rejected under 35 U.S.C. 102(a) as being anticipated by Starcke (U.S. Patent 5,853,826).

15. Starcke discloses an article having a first coating layer of titanium and a second coating layer of titanium nitride (e.g. see claim 5).

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16. Claims 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Enomoto (Japanese publication 4-82502).

17. Enomoto discloses an article having a first coating layer of titanium and a second coating layer of titanium nitride (e.g. see abstract and entire document). Although it is noted that Enomoto may contain a third top layer of SiAlON, applicant's claims use "consisting essentially". If applicant contends that components in the prior art are excluded by the recitation of "consisting essentially of", applicant has the burden of showing that the basic and novel characteristics of the claimed invention are materially affected by those components, *In re De Lajarte*, 143 USPQ 256 (CCPA 1964).

18. Claims 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Momoki (Japanese publication 61-105769).

19. Momoki discloses an article having a first coating layer of titanium and a second coating layer of titanium nitride (e.g. see abstract and entire document).

20. Claims 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Moysan (U.S. Patent 5,413,874), Moysan (U.S. Patent 5,476,724), Moysan (U.S. Patent 5,484,663), Moysan

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(U.S. Patent 5,552,233), Moysan (U.S. Patent 5,626,972), Moysan (U.S. Patent 5,639,564) or Moysan (U.S. Patent 5,641,579).

21. Each of the Moysan references disclose an article comprising a substrate and multiple layers. On these articles are applied a layer of zirconium or titanium followed by a layer of zirconium compound or titanium compound (e.g. see the claims of each patent).

Response to the Preliminary Amendment

22. Applicant's Preliminary Amendment filed with this application on November 5, 2001 has added the insertion of "consisting essentially of" language of the claims. However, when applicant contends that components in the prior art are excluded by the recitation of "consisting essentially of", applicant has the burden of showing that the basic and novel characteristics of the claimed invention are materially affected by those components, *In re De Lajarte*, 143 USPQ 256 (CCPA 1964). A careful review of the original disclosure shows no factual evidence that any extraneous layers used by the applied art materially affect the basic and novel characteristics of the applicant's invention. Indeed, in view of the lack of discussion in the specification as to the specific function of some of the individual layers and compositions, it is not clear how any basic and novel characteristics can be attributed specifically to those layers or compositions. In any event, in view of the similar subject matter and similar goals of most of the applied art, it is doubtful that dissimilar basic and novel characteristics would be found in the layers and compositions of the

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analogous applied art. Until applicant fulfils applicant's burden, the "consisting essentially of" language of the claims must be interpreted as "open" to the additional constituents and/or layers found in the applied art.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Zimmerman whose telephone number is (703) 308-2512 and whose fax number is (703) 872-9310.



**JOHN J. ZIMMERMAN
PRIMARY EXAMINER**

jjz
February 20, 2002